

D. REMARKS

The Examiner restricts the application to one of two claim groupings. Applicants traverse the requirement by the Examiner to elect one grouping with respect to claims 37-42, however would elect group I for examination in compliance with 37 CFR 1.143. In addition, Applicants cancel claims 43-59.

Alleged Grounds of Restriction

In paragraph 1, the Examiner specifies group I as containing claims 1-36 which are “drawn to a method and a system for predicting fraudulent identification usage in a telephone network, classified in class 279, subclass 145.” [Office Action, p. 2] In contrast, the Examiner specifies group II as containing claims 37-59 which are “drawn to protecting credit card fraud, classified in class 235, subclass 380.” [Office Action, p. 2]

Next, in paragraph 2, the Examiner states that “Inventions I and II are related as combination and subcombination.” [Office Action, p. 2] The Examiner cites MPEP 806.05(c) which states “Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations.” [Office Action, p. 2] The Examiner concludes that “In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I is directly drawn to a method and a system for predicting fraudulent identification usage in a telephone network. The subcombination has separate utility such as protecting credit card fraud in a credit card system.” [Office Action, p. 2]

Group I is Improperly Characterized

Applicants respectfully disagree with the Examiner’s characterization of group I as drawn to “a method and system for predicting fraudulent identification usage in a telephone network”. In particular, Applicants respectfully disagree with the Examiner’s characterization of group I because Applicants respectfully disagree with the Examiner’s assertion that claims 1-18

Application No. 10/022,165
Docket # AUS920010844US1

15

are drawn to a method for predicting fraudulent identification usage *in a telephone network*.

Claim 1 reads:

- 1.(Original) A method for predicting fraudulent identification usage, comprising:
 - detecting a context for a use of an identification via a communication line at a fraud protection service;
 - analyzing said context for use of said identification in view of a plurality of entries for use of said identification; and
 - specifying a level of suspicion of fraudulent use of said identification according to said analysis of said context.

Claim 1 teaches detecting a context for use of an identification via a communication line at a fraud protection service. Claim 1 does not include a limitation of a telephone network. Thus, Applicants respectfully disagree with the Examiner's characterization of group I as limited in scope to usage in a telephone network and request an amended basis for restriction of group I that does not require usage in a telephone network.

Claims 37-42 are Improperly Restricted from Group I

Applicants respectfully disagree with the Examiner's restriction of claims 37-42 into Group II. In particular, Applicants respectfully disagree with the Examiner's restriction of claims 37-42 into Group II because the scope of the invention described in Group I is improper. As previously stated, the scope of the invention described in Group I is improper because the scope includes usage in a telephone network but claim 1 of Group I is not restricted to usage in a telephone network. Additionally, Applicants assert that Group I is improperly limited to a method and system and therefore improperly excludes claims 37-42 which constitute the same essential distinguishing features as the claims in Group I.

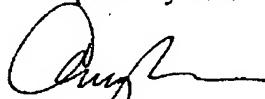
In evaluating whether inventions are distinct, one example provided in MPEP 806.05(c) for when no restriction is proper states "If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has Application No. 10/022,165
Docket # AUS920010844US1

separate utility.” Applicants respectfully assert that defining the scope of the combination in Group I as limited to “method” and “system” is improper. In contrast, Applicants respectfully assert that the same elements that are common between claims 1 and 19 are also common in claim 37 and therefore the relationship between the claims is such that claim 37 constitutes the essential distinguishing feature of the Group I combination. In particular, Applicants note that independent claims 1, 19, and 37 all include the same elements drawn to “predicting fraudulent identification usage”. Independent claims 1 and 19 include the common elements of “detecting a context for a use of an identification via a communication line”, “analyzing said context for use of said identification in view of a plurality of entries for use of said identification”, and “specifying a level of suspicion of fraudulent use of said identification according to said analysis of said context.” Claim 37 includes the same common elements as claims 1 and 19. Thus, Applicants respectfully assert that where claim 37 includes the same elements claims 1 and 19, it is improper to distinguish claim 37 in a separate grouping merely because claim 37 is a computer program product instead of a method or system for performing the same elements. Therefore, since there is no evidence that the common elements of claims 1 and 19 in Group I are patentable without the same common elements in claim 37, restriction should not be required and is improper. Applicants respectfully request that the Examiner adjust the scope of Group I so that independent claim 37 and dependent claims 38-42 are no longer improperly restricted to Group II.

Conclusion

In view of the foregoing, Applicant respectfully requests that a corrected election requirement be issued. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

 on 8/19/05

Amy J. Pattillo
Attorney for Applicants
Registration No. 46,983
P.O. Box 161327
Austin, Tx 78716
vox 512-402-9820
fax 512-306-0417